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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,605	06/01/2001	Akihiro Teramachi	010713	8594
23850	7590	06/15/2005	EXAMINER	
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP 1725 K STREET, NW SUITE 1000 WASHINGTON, DC 20006			CHOI, PETER H	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,605

Applicant(s)

TERAMACHI, AKIHIRO

Examiner

Peter Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f)..
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-12 are pending in the application.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- In Figure 11, reference character s38 is used to represent "Send Refusal of Access". However, this reference character is not cited in the specification. The reference character used is step s36 (line 15 of page 20 of the specification), but Figure 11 and the specification already designate that reference character to represent "Report Retrieval Result".

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- In Figure 12, reference character s55 is used to represent "Output Information". However, this reference character is not cited in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Eisenhart (PGPub 2001/0047276).

As per claim 1, Eisenhart teaches an open research and development method comprising the steps of:

sending membership solicitation information (**registration data**) to a communications network (**using Internet 100**) from a predetermined server (**at a web-based presentation interface on a pedestrian web site**) [Paragraphs 12 and 31];

causing an applicant for membership to report predetermined items (**registration data including company contact information, personal contact information, role performed, requested login account, company affiliation, electronic mail address**) from a network terminal (**computer**) operated by the applicant, by way of the communications network (**using Internet 100**) [Paragraphs 12 and 105];

performing examination operation (**verification of qualifications**) on the reported information (**registration data, contact information**) in connection with membership registration [Paragraphs 12, 45 and 105];

registering the (**identification**) information about the applicant into a membership database (**database 340**) (**as a member or personal profile**) on at least the condition that the applicant should have passed the examination operation (**user is a member**) [Paragraphs 13, 45, 46]; and

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accumulating, into a knowledge database (**collection of resources {editorial content, templates, tools, links, discussion forums, etc.} into a digital library**) , information which has been transmitted from members (**member profile listings**) registered in the membership database by way of the communications network in relation to a specific topic (**organized by topic, type of deal sought, targeted industry segment**) [Paragraphs 52, 54].

As per claim 2, Eisenhart teaches the open research and development method according to claim 1, further comprising the steps of:

selecting members for which provision of information is to be requested (**establishing a need profile**), by utilization of information about the members (**member profile and need profile of member**) registered in the membership database [Paragraph 14]; and

requesting the selected members (**request direct contact with the business partner to advance the evaluation**) to offer engineering information (**confidential data such as technical documents, test results, and empirical studies**) by way of the communications network [Paragraphs 14 and 33].

As per claim 3, Eisenhart teaches the open research and development method according to claim 1, further comprising the steps of:

submitting given inquiries to the applicant (**request for registration data**) by way of the communications network (**Internet 100**) [Paragraphs 12 and 31]; and

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determining whether to register the applicant as a member (**qualifying the potential member**), on the basis of answers provided (**registration data and contact information**) in response to the inquiries [Paragraphs 12 and 45].

As per claim 4, Eisenhart teaches the open research and development method according to any one of claims 1 through 3, wherein the items to be reported by the applicant include items to be used for grasping the applicant's experience (**personal work history**) in research and development [Paragraph 13].

As per claim 6, Eisenhart teaches the open research and development method according to claim 1, wherein the communications network corresponds to the Internet (**Internet 100**), and the membership solicitation information (**registration data**) is sent from a WWW server via the Internet (**community web site 320 using Internet 100**) [Paragraphs 12, 31 and 42].

As per claim 7, Eisenhart teaches an open research and development system comprising:

means (**Internet 100, mail server 301, pedestrian website 310, and private mail server 350**) for sending membership solicitation information (**registration data**) to a communications network (**through the pedestrian web site**) [Paragraphs 12, 31, 38 and 41];

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means (**Internet 100, mail server 301, pedestrian website 310 and private mail server 350**) for sending items (**registration data including company contact information, personal contact information, role performed, requested login account, company affiliation, electronic mail address**) to be reported at time of application for membership to a network terminal (**computer**) operated by an applicant, by way of the communications network (**Internet 100**) [Paragraphs 12, 38, 41, and 105];

means for acquiring the items (**registration component 321 receives registration and identification data**) which are transmitted from the network terminal by way of the communications network (**Internet 100**) and for performing an examination (**verification of qualifications by qualification component 322**) in connection with membership registration on the basis of the received information (**registration data, contact information**) [Paragraphs 12, 45 and 105];

means for registering (**registration component 321**) the (**identification**) information about the applicant into a membership database (**database 340**) (**as a member or personal profile**) at least on condition that the applicant has passed the examination (**user is a member**) [Paragraphs 13, 45, 46]; and

means (**Collaboration Manager 325 containing Directory browsing component 430 and Custom feed component 410**) for accumulating, into knowledge database (**collection of resources {editorial content, templates, tools, links, discussion forums, etc.} into a digital library**), information which pertains to a certain topic (**organized by topic, type of deal sought, targeted industry segment**) and which has been sent from a member registered in the membership database (**member**

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with member profile listed) by way of the communications network (**Internet 100**).

[Paragraphs 51-52,54-55]

As per claim 8, Eisenhart teaches the open research and development system according to claim 7, further comprising:

means (**Screening and match-making component 440**) for selecting members for which provision of information (**establishing a need profile**) is to be requested, by utilization of information about the members (**member profile and need profile of member**) registered in the membership database [Paragraphs 14 and 55]; and

means (**Communication manager 326 to send and receive electronic mail messages**) for requesting the selected members (**request direct contact with the business partner to advance the evaluation**) to offer engineering information (**confidential data such as technical documents, test results, and empirical studies**) by way of the communications network [Paragraphs 14, 33 and 48].

As per claim 9, Eisenhart teaches the open research and development system according to claim 7, wherein the means for sending items (**Internet 100, mail server 301, pedestrian website 310, and private mail server 350**) to be reported at the time of application for membership submits given inquiries (**request for registration data**) to the applicant by way of the communications network (**Internet 100**) [Paragraphs 12 and 31, 38 and 41]; and the means for performing an examination (**verification of qualifications by qualification component 322**) performs an examination (**qualifying**

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the potential member) on the basis of answers provided (**registration data and contact information**) in response to the inquiries [Paragraphs 12, 45 and 105].

As per claim 10, Eisenhart teaches the open research and development system according to claim 7, wherein the items to be reported for application by the applicant includes items to be used for grasping the applicant's experience (**personal work history**) in research and development [Paragraph 13].

As per claim 12, Eisenhart teaches the open research and development system according to claim 7, wherein the communications network corresponds to the Internet (**Internet 100**), and the membership solicitation information (**registration data**) is sent from a WWW server via the Internet (**community web site 320 using Internet 100**) [Paragraphs 12, 31 and 42].

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenhart.

As per claim 5, Eisenhart teaches the open research and development method according to claim 1, further comprising the steps of:

concluding a secrecy memorandum (**exclusive review agreement and nondisclosure agreement**) with the applicant who has passed the examination operation (**member**) [Paragraphs 15 and 90]

Eisenhart teaches a digital notarization of key documents (such as exclusive review agreements). Official Notice is taken that it is old and well known in the art that digital copies of documents (such as digitally notarized documents) can be transmitted between users through means that are also old and well known in the art (Internet, electronic mail, file transfer protocol, etc.). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Eisenhart to include the step of using the Internet to conclude a secrecy memorandum between users as a efficient, low-cost means of ensuring that both parties have received certified notarized copies of the exclusive review agreement.

Eisenhart does not explicitly teach the step of admitting membership registration of the applicant only if the applicant has concluded the secrecy memorandum. However, Eisenhart teaches a system where registered users are required to conduct an exclusive review agreement with potential members whom they wish to collaborate with before an exchange of information can occur. Only when an agreement of collaboration

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is made and notarized can either party access a secure collaboration area in a project portal [Paragraphs 47 and 86]. Members who do not have such agreements in place are only permitted to view non-sensitive information, such as member profiles, need profiles of users, and a catalog of technology innovations available for exchange. Members who have agreed to the exclusive review agreements are enabled to view and exchange sensitive information, whereas members without such agreements are only able to view non-sensitive information, accomplishing the same task as only allowing membership to users agreeing to non-disclosure agreements, meeting the limitation of the claim.

As per claim 11, Eisenhart teaches the open research and development system according to claim 7, further comprising:

means **(Secure collaboration manager 331 and Contract manager 530)** for submitting a secrecy memorandum **(exclusive review agreement and nondisclosure agreement)** to the applicant who has passed the examination operation **(member)**, by way of the communications network [Paragraphs 15, 84 and 90]; and

means **(Deal tracker component 450, which contains acceptance component 458)** for determining whether or not the involved parties have agreed on the secrecy memorandum **(when a supplier and either a buyer or contributor reach an agreement during the course of the negotiation of a notarized document of an exclusive review agreement)** on the basis of the information transmitted from the network terminal in response to the submitted secrecy memorandum [Paragraphs 63, 83-86] .

As cited above, Eisenhart does not explicitly teach the step of admitting membership registration of the applicant only if the applicant has concluded the secrecy memorandum. However, Eisenhart teaches a system where registered users are required to conduct an exclusive review agreement with potential members whom they wish to collaborate with before an exchange of information can occur. Only when an agreement of collaboration is made and notarized can either party access a secure collaboration area in a project portal [Paragraphs 47 and 86]. Members who do not have such agreements in place are only permitted to view non-sensitive information, such as member profiles, need profiles of users, and a catalog of technology innovations available for exchange. Members who have agreed to the exclusive review agreements are enabled to view and exchange sensitive information, whereas members without such agreements are only able to view non-sensitive information, accomplishing the same task as only allowing membership to users agreeing to non-disclosure agreements, meeting the limitation of the claim.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nielsen (U.S Patent #5,948,054) teaches a method and system for facilitating the exchange of information between human users in a networked computer system. A

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record of each user is maintained in a database and stores qualification and contact information.

Marpe et al. (U.S Patent #6,671,693) teaches a system for effectively collecting and disseminating data. Data is retrieved from multiple users in a plurality of categories. Users can use an interface to view the plurality of data categories and access the data therein.

Kristin Staroba teaches the benefits of using online services to deliver information. Online communication can link members to other members. Web sites typically describe the organization and member benefits, and offer online applications, online registration, and post some sort of index to publications. Member information is stored on membership databases.

Elliot Turner Nalley teaches judicial rulings by the U.S Court of Appeals governing intellectual property laws.

Jim Hunter discloses the importance of companies using nondisclosure agreements to prevent ex-employees from exploiting sensitive commercial knowledge.

David Dubberly teaches that non-disclosure agreements protect competitive edge. Employers in South Carolina are taking proactive steps to ensure that their trade

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secrets are protected by state and federal law. One step that can be taken to prevent theft of confidential information by competitors and/or employees is to require employees to sign covenants not to disclose trade secrets during or after employment. The federal Economic Espionage Act (EEA) makes it a crime to take, copy, or receive trade secrets without the permission of the owner. Dubberly teaches that a signed acknowledgement form stating that the employee received, read, and understood the handbook should be kept in each employee's personnel file. Dubberly also teaches that employers should have a policy for protection, retention, and destruction of confidential documents, including procedures for marking confidential documents. Additional measures that employers can use to prevent the disclosure of confidential information includes storing confidential information in locked files and locked rooms, limiting employees' access to confidential information on a need-to-know basis, using pass codes for computer access which are changed frequently, limiting computer access for certain types of information, and restricting visitor access to areas in which secret processes or machines operate, or are being developed, and requiring all visitors to sign a log and be escorted by appropriate employees.

CSER Membership Agreement is an example of the membership agreement for applicants desiring to be a member of CSER, a corporation that was constituted for the purpose of carrying on and promoting scientific research and experimental development. The applicant recognizes the benefits of sharing results of research and state a desire in sharing with other members the results of their research.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (571) 272 6971. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PC
June 10, 2005

Susanne Diaz
Susanne Diaz
Primary Examiner
Au 3623